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| 09/892,923 | 06/26/2001 | Bret P. O'Rourke | MS1-655US | 3843 |
| 22801 | 7590 | 02/23/2004 | EXAMINER | |
| LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201 | | | GODDARD, BRIAN D | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

SR

Office Action Summary

Application No.

09/892,923

Applicant(s)

O'ROURKE ET AL.

Examiner

Brian Goddard

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This communication is responsive to Amendment A, filed 01 December 2003.
2. Claims 1-44 are pending in this application. Claims 1, 17, 20 and 31 are independent claims. In Amendment A, no claims were cancelled or added, and claims 1-20, 22-23, 28-30, 32-36 and 42-43 were amended. This action is made Final.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 11, 13-16, 18 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of terminology "and/or" in claims 11, 13, 18 and 29 is considered indefinite because it is unclear whether all limitations in the list must be present or just one. In the interest of compact prosecution, the examiner assumes that "or" is claimed wherever "and/or" is recited.

Claims 14-16 are dependent upon claim 13, and are therefore indefinite for the same reason as claim 13.

Claim Rejections - 35 USC § 103

4. Claims 1-4, 6-7, 20-21, 23, 25, 30-34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. US 2002/0138844 to Otenasek et al. in view of U.S. Patent Application Publication No. US 2001/0036355 to Kelly et al.

Referring to claim 1, Otenasek discloses a system and method for managing streaming media content as claimed. See Figures 1-3 and the corresponding portions of Otenasek's specification for this disclosure. In particular, Otenasek teaches a method [See Fig. 3] for managing streaming media content [digital audio/video], the method comprising:

accessing [Step 100], by a computing device [See Figs. 1-3], a first playlist [multimedia file (video)] that has a non-canonical data format ['any compressed video file type' (See paragraph 0031)];

providing, by a computing device, a plurality of translators [COM functions for encoding to standard format] that translate playlists [See paragraph 0031] from a plurality of different non-canonical formats ['any compressed video file type' (See paragraph 0031)] to a canonical playlist format [any encoding standard, AVI format in preferred embodiment];

calling [Step 200], by a computing device, one of the translators to translate the first playlist into the canonical playlist format, forming a second playlist [AVI file] in the canonical playlist format; and

retrieving [Steps 300-400], by a computing device, media content ['sequence of "moving images"' (See paragraph 0024)] referenced by the second playlist as claimed.

Otenasek does not explicitly use the term "playlist" to describe the multimedia content that is provided. However, it is the position of the examiner that Otenasek's streaming multimedia files (e.g. AVI files) fit the generic definition of a "playlist" provided in the instant specification. It is noted that no single, explicit definition of "playlist" is provided in the instant application. Examples are provided as to what a playlist may be or what a "playlist file" may include. Therefore, the examiner is left to determine the broadest reasonable interpretation of the term "playlist" in light of the specification. Otenasek's streaming media files contain sequences of smaller media objects (e.g. audio data and still image data) describing how the pieces of media (e.g. audio and image data) are combined into one single complex piece of content (e.g. a streaming video). This being described in the exemplary discussion of "playlists" on pages 2 & 3 of the instant specification, Otenasek's streaming multimedia files are considered to be "playlists" as claimed.

Assuming *arguendo* that Otenasek's streaming multimedia file is not a "playlist" as claimed, the irrefutable similarities provide direct suggestion for housing, translating, and streaming "playlists" as Otenasek's streaming multimedia content, especially since Otenasek explicitly states that any type of multimedia content or encoding standard could be used. See paragraph 0031 for this disclosure.

Kelly discloses a system and method similar to that of Otenasek, wherein the content stored, translated, and streamed is organized by a "playlist" as claimed. See paragraphs 0009-0093, 0117 and 0123 of Kelly's specification for the details of this disclosure.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Kelly's playlists in the streaming multimedia content of Otenasek's system and to apply Otenasek's processing method above to these playlists as claimed. One would have been motivated to do so because of the suggestion provided by Otenasek as discussed above.

Referring to claim 2, Otenasek v. Kelly discloses the method for managing streaming media content as claimed. See paragraphs 0013 and 0024 of Otenasek's specification for this disclosure. In particular, Otenasek's (as modified by Kelly) step of retrieving media content referenced by the second playlist further comprises: streaming, by the server, content referenced by the second playlist [See paragraph 0024 & the discussion of step 400] to a client computing device [content review/control site 20 & viewer(s) 50-1 – 50-n] as claimed.

Referring to claim 3, Otenasek v. Kelly discloses the method for managing streaming media content as claimed. See Figures 1 & 2 and the corresponding portions of Otenasek's specification for this disclosure. In particular, Otenasek's (as modified by Kelly) method is performed by a single computing device [Administrator Server 40] and the step of retrieving media content referenced by the second playlist further comprises: rendering/playing, by the single computing device, the content referenced by the second playlist [See step 200] in a manner that the single computing device [Administrator 40] is a client [40-1 – 40-n (See Fig. 2)] for the content" as claimed.

Referring to claim 4, Otenasek v. Kelly discloses the method for managing streaming media content as claimed. See paragraphs 0024 and 0031 of Otenasek's

specification for this disclosure. In particular, Otenasek's (as modified by Kelly) step of forming a second playlist in the canonical format comprises "dynamically generating [digitally encoding the file], by a computing device, a data structure [AVI file (Otenasek), playlist file as modified by Kelly] comprising the second playlist [see above], the data structure being used to manage streaming content referenced by the second playlist [definition of an AVI file (RIFF), or any other canonical multimedia file]" as claimed.

Referring to claim 6, Otenasek v. Kelly discloses the method for managing streaming media content as claimed. See paragraphs 0024, 0031-0032 and 0043 of Otenasek's specification for this disclosure. In particular, Otenasek's (as modified by Kelly) method further comprises dynamically streaming [See paragraph 0024 & the discussion of step 400], by a server computing device, a different set of media content [a different file: any other file in the dynamic database] to a client [50-1 – 50-n] computing device coupled to the server computing device across a network, the different media content not being represented in the second playlist [content from another AVI file entirely] as claimed.

Referring to claim 7, Otenasek v. Kelly discloses the method for managing streaming media content as claimed. See paragraph 0031 of Otenasek's specification for this disclosure. In particular, Otenasek's (as modified by Kelly) plurality of translators [encoders] are COM objects as claimed.

Claim 20 is rejected on the same basis as claim 2. See the discussions regarding claims 1-2 above for the details of this disclosure. In particular, Otenasek's (as modified by Kelly) method is implemented on a computer-readable media [on

Art Unit: 2171

Administrator 40] comprising computer-executable instructions comprising a playlist server component [40] and a plurality of translator components [see claim 1 above] as claimed.

Claim 21 is rejected on the same basis as claim 3, in light of the basis for claim 20 above. See the discussions regarding claims 1 and 3 above for the details of this disclosure.

Claim 23 is rejected on the same basis as claim 6, in light of the basis for claim 20 above. See the discussions regarding claims 1 and 6 for the details of this disclosure.

Claim 25 is rejected on the same basis as claim 7, in light of the basis for claim 20 above. See the discussions regarding claims 1 and 7 for the details of this disclosure.

Claim 30 is rejected on the same basis as claim 20. See the discussion regarding claim 20 above, as well as Fig. 2 and the corresponding portion of Otenasek's specification for this disclosure.

Claims 31-33 are rejected on the same basis as claims 1-3 respectively. See the discussions regarding claims 1-3 above for the details of this disclosure.

Claim 34 is rejected on the same basis as claim 7, in light of the basis for claim 31 above. See the discussions regarding claims 1 and 7 for the details of this disclosure.

Claim 36 is rejected on the same basis as claim 6, in light of the basis for claim 31 above. See the discussions regarding claims 1 and 6 for the details of this disclosure.

5. Claims 8-9, 24 and 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otenasek in view Kelly as applied to claims 1, 20 and 31 above, and further in view of U.S. Patent No. 6,564,263 to Bergman et al.

Referring to both claims 8 and 9, Otenasek (as modified by Kelly) discloses the method of claim 1 as above, wherein the canonical playlist format is AVI format (Otenasek) or MPEG TS format (Kelly) and an AVI encoder interface is used to create the second playlist. Neither Otenasek nor Kelly explicitly teach the use of a SMIL data format and a SMIL interface as claimed. However, Otenasek does state that any common encoding standard could be used in place of AVI. See paragraph 0031 for this disclosure.

Bergman discloses a system and method similar to those of Otenasek and Kelly, and specifically teaches the commonality of the SMIL data format for use in similar systems. See column 2, lines 37-56 of Bergman's specification for this disclosure. Thus, Bergman teaches that the SMIL data format was a common encoding standard at the time of applicants' invention.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a SMIL interface to create Otenasek's (as modified by Kelly) canonical playlists in a SMIL data format as opposed to the AVI format

Art Unit: 2171

disclosed. One would have been motivated to do so because of Otenasek's direct suggestion shown above.

Claim 24 is rejected on the same basis as claim 8, in light of the basis for claim 20 above. See the discussions regarding claims 1 and 8 for the details of this disclosure.

Claims 38-39 are rejected on the same basis as claims 8-9 respectively, in light of the basis for claim 31 above. See the discussions regarding claims 1 and 8-9 for this disclosure.

6. Claims 5, 10-19, 22, 26-29, 35, 37 and 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otenasek in view of Kelly as applied to claims 1, 20 and 31 above, and further in view of U.S. Patent No. 5,974,503 to Venkatesh et al.

Referring to claim 5, Otenasek (as modified by Kelly) does not explicitly teach the ability to dynamically interrupt a particular media item as it is being streamed from the second playlist as claimed. This, however, is only because Otenasek is silent on detailed functionality of the actual streaming process. Kelly's playlist format, as applied to the system and method of Otenasek, allows for modification/editing of the content items. This provides suggestion for allowing the content items to be modified or edited dynamically during streaming.

Venkatesh discloses a system and method similar to that of Otenasek, wherein the streaming media (audio/video) can be dynamically interrupted for insertion, deletion, or other editing of media items being streamed from a playlist. See Figures 34-37 and

the corresponding portions of Venkatesh's specification for this disclosure. In particular, Venkatesh teaches dynamically interrupting [editing break-in] a particular media item [clip] as it is being streamed ['during playback of clips in the playlist... during the streaming of continuous media data' (column 44, lines 44-51)] from a playlist as claimed. Refer specifically to columns 44-48 for the details of this disclosure.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add Venkatesh's dynamic playlist editing functionality to the system and method of Otenasek v. Kelly so as to allow dynamic interruption of a streaming media item for editing of the playlist. One would have been motivated to do so in order to afford the user greater control and functionality in the streaming of media content to a client terminal, as provided by Venkatesh.

Referring to claim 10, the system and method of Otenasek in view of Kelly and Venkatesh as applied to claim 5 above discloses the invention as claimed. See Figures 34-37 and the corresponding portions of Venkatesh's specification for this disclosure. In particular, Otenasek in view of Kelly and Venkatesh teaches the method as recited in claim 1, further comprising:

providing, by a computing device, one or more transformers [Venkatesh's dynamic playlist editing functions] that impose respective policies [editing functions] on content referenced by the first playlist; and

notifying [issuance of an edit command], by a computing device, at least one transformer of the one or more transformers to impose a policy [edit function] on the content referenced by the second playlist as claimed.

Referring to claim 11, the system and method of Otenasek in view of Kelly and Venkatesh as applied to claim 10 above discloses the invention as claimed. See columns 44-48 of Venkatesh's specification for this disclosure. In particular, Otenasek in view of Kelly and Venkatesh teaches the method of claim 10, wherein imposing the policy [edit function] results in a modification to the second playlist, the modification being (a) removing a reference [clip] from the second playlist, or (b) adding a reference [clip] to the second playlist as claimed.

Referring to claim 12, the system and method of Otenasek in view of Kelly and Venkatesh as applied to claim 10 above discloses the invention as claimed. Venkatesh's dynamic playlist editing functions (transformers), as added to the system and method of Otenasek v. Kelly above, are not explicitly disclosed as COM objects as claimed. However, Otenasek's translators/encoders are explicitly disclosed as COM objects. Thus, in adding Venkatesh's dynamic playlist editing functions (transformers) to Otenasek's (as modified by Kelly) system as above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement them as COM objects to obtain the invention as claimed. One would have been motivated to do so in order to conform to Otenasek's server structure as described above.

Claim 13 is rejected on the same basis as claim 11. See the discussion regarding claim 11 above for the details of this disclosure.

Claim 14 is rejected on the same basis as claim 11, in light of the basis for claim 5 above. See the discussions regarding claims 1, 5 and 10-11 for the details of this disclosure.

Referring to claim 15, the system and method of Otenasek in view of Kelly and Venkatesh as applied to claim 13 above discloses the invention as claimed. See the discussions above and the relevant portions of each specification for the details of this disclosure. In particular, Otenasek in view of Kelly and Venkatesh discloses the method as recited in claim 13, the operations further comprising:

dynamically interrupting, by the supervisory component, a particular media item as it is being streamed [see discussion of claim 5 above];

streaming, by the supervisory component, another media item [clip added to the playlist]; and

resuming, by the supervisory component, a set of operations specified by the second playlist [continuing regular playback of the playlist after the inserted clip]" as claimed.

Claim 16 is rejected on the same basis as claim 12, in light of the basis for claim 13 above. See the discussions regarding claims 1, 10, 12 and 13 for the details of this disclosure.

Claim 17 is rejected on the same basis as claim 10. See the discussions regarding claims 1 and 10 above for the details of this disclosure.

Claim 18 is rejected on the same basis as claim 11, in light of the basis for claim 10 above. See the discussions regarding claims 1, 10 and 11 for the details of this disclosure.

Claim 19 is rejected on the same basis as claim 17. See the discussion regarding claim 17 above for the details of this disclosure. In particular, the method of

Otenasek in view of Kelly and Venkatesh is implemented on a computer-readable media [on Otenasek's Administrator 40] comprising computer executable instructions as claimed.

Claim 22 is rejected on the same basis as claim 5, in light of the basis for claim 20 above. See the discussions regarding claims 1 and 5 above for the details of this disclosure.

Claim 26 is rejected on the same basis as claim 14, in light of the basis for claim 20 above. See the discussions regarding claims 1 and 14 above for the details of this disclosure.

Referring to claim 27, the system and method of Otenasek in view of Kelly and Venkatesh as applied to claim 26 above discloses the invention as claimed. See column 44, lines 51-56 of Venkatesh's specification, as well as the portions of Otenasek's specification mentioned above, for the details of this disclosure. In particular, Venkatesh's dynamic playlist editing functions (supervisory component) uses a graphical user interface to visualize and manually manipulate elements [clips] and attributes [headers, etc.] of the canonical playlist as claimed.

Claims 28-29 are rejected on the same basis as claims 10-11, in light of the basis for claim 20 above. See the discussions regarding claims 1 and 10-11 for the details of this disclosure.

Claim 35 is rejected on the same basis as claim 5, in light of the basis for claim 31 above. See the discussions regarding claims 1 and 5 for the details of this disclosure.

Claim 37 is rejected on the same basis as claim 15, in light of the basis for claim 31 above. See the discussions regarding claims 1 and 15 for the details of this disclosure.

Claims 40-44 are rejected on the same basis as claims 10-14 respectively, in light of the basis for claim 31 above. See the discussions regarding claims 1 and 10-14 for the details of this disclosure.

Response to Arguments

7. Applicant's arguments with respect to claims 1-44 have been considered but are moot in view of the new ground(s) of rejection.

Referring to applicants' remarks on pages 17-21 regarding the Section 102 rejection of independent claim 1: Applicants argued that Otenasek's media content is not stored in a "playlist" as claimed.

The examiner disagrees for the following reasons: Applicants rely on the background section of the specification (pages 2-3) for the description of the claimed term "playlist". First, no single, explicit definition of "playlist" is provided in the instant application. Examples are provided as to what a playlist may be or what a "playlist file" may include. Therefore, the examiner is left to determine the broadest reasonable interpretation of the term "playlist" in light of the specification. Otenasek's streaming media files contain sequences of smaller media objects (e.g. audio data and still image data) describing how the pieces of media (e.g. audio and image data) are combined into one single complex piece of content (e.g. a streaming video). This being described in

the exemplary discussion of "playlists" on pages 2 & 3 of the instant specification, Otenasek's streaming multimedia files are considered to be "playlists" as claimed.

Second, the description in the cited portions of the instant specification is directed mainly to a "playlist file", not a playlist. The claims recite "a first playlist", "playlists", "a canonical playlist format", and "a second playlist", but never a "playlist file". Thus, the described "playlist file" is not actually claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Finally, even assuming *arguendo* that Otenasek does not teach a "playlist", this argument is moot in view of the new grounds of rejection set forth above.

Referring to applicants' remarks on pages 21-40: Applicants arguments all rely on the supposed difference between Otenasek's multimedia content and the claimed "playlist" as discussed above. These arguments are moot in view of the new grounds of rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,349,797 to Newville et al. and U.S. Patent Application Publication No. 2002/0067730 to Hinderks et al. are each considered pertinent to applicants' claimed invention.

The remaining prior art of record and not relied upon is considered pertinent to applicants' disclosure as well as portions of applicants' claimed invention.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goddard whose telephone number is 703-305-7821. The examiner can normally be reached on M-F, 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for

Art Unit: 2171

the organization where this application or proceeding is assigned is (703) 872-9306 for all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

bdg
18 February 2004


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
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